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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,233	08/03/2001	Simon Erani	4061.007	8232

7590 10/06/2004  
Morris E. Cohen  
Suite 217  
1122 Coney Island Avenue  
Brooklyn, NY 11230-2345

EXAMINER

CRIARES, THEODORE J

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/922,233

**Applicant(s)**

ERANI, SIMON

**Examiner**

Theodore J. Criares

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 2,7,20,25 and 34-37 is/are allowed.
- 6) ☒ Claim(s) 1,3-5,8-19,21-24,26-33 and 38-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/7/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **CLAIMS 1-41 ARE PRESENTED FOR EXAMINATION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.117(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.117(e) had been timely paid, the finality of the previous Office Action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 7, 2004 has been entered with the following effect:

Claims 2, 7, 20, 25 and 34-37 are allowed.

### **Reply to Argument**

Applicant's arguments filed June 7, 2004, have been fully considered but they are not persuasive. Applicant argues that the Vitamin C (ascorbylmethylsilanol pectinate) and VITAZYME D TM (Vitamin D polypeptide) compounds utilized in applicant's claimed invention are uncommon forms. However, the applicant is claiming a cosmetic composition **comprising** compounds a) to e) as set forth in the claims submitted June 7, 2004.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 3-6, 8-19, 21-24, 26-33 and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Brooks Industries, inc. Cosmetic Ingredients & Ideas<sup>R</sup> Protein Bonded Vitamins" (Brooks II) in view of French Patent 2746008 ('008).

Brooks II teaches that compounds a and c-d are well known vitamins to formulate cosmetics for the skin. The difference between applicant's claimed invention, as argued in his remarks, is the lack of ascorbylmethylsilanol pectinate, in a cosmetic formulation. However, one of ordinary skill in the art would have been motivated to use this uncommon vitamin in a cosmetic formulation as taught by Brooks II since '008 teaches at page 4, that Ascorbosilane C, applicant's ascorbylmethylsilanol pectinate, is used in skin cosmetics to protect degradation of collagen.

As stated in *In re Kerkhoven*, 626 F.2d 846, 205 USPQ 1069, at page 1072 (CCPA 1980):

"It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition which is to be used for the very same purpose. *In re Susi*, 58 CCPA 1074, 1079-80, 440 F.2d 442, 445, 169 USPQ 423, 426 (1971); *In re Crockett*, 47 CCPA 1018, 1020-21, 279 F.2d 274, 276-277, 126 USPQ 186, 188 (CCPA 1960).

As this court explained in *Crockett*, the idea of combining them flows logically from their having been individually taught in the prior art. "

In this application it would have been prima facie obvious to include applicant's claimed ascorbylmethylsilanol pectinate in the skin formulation of known agents which are used in the treatment of skin conditions.

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Claims 6, 8-10 18, 24, 26-28 and 41 which recite the addition of glycolic acid to the formulation is within the skill of the art is illustrated in the patent to Zaveri (5,958,437). At column 2, lines 47-56 it is taught to be used as a stabilizer in a cosmetic composition for the skin.

Claims 11-14 which recite various means of applying the claimed composition to the skin is also within the skill of the art column 4, line 48 to column 5, line 61 as illustrated in the patent to Fotinos (6,346,255). At column 4, lines 48-59 the concentrations of claims 15-17, 33 and 38-40 the concentrations of cosmetic formulations are shown to be common to the art. This extrinsic evidence establishes that it was known to the art to use glycolic acid and the concentration in formulating cosmetics with a reasonable expectation of success.

The test of obviousness is "whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention." In re Gorman, 933 F.2d 982, 18 USPQ 2d 1885, (Fed. Cir. 1991). In view of the above rejection it is deemed that the evidence presented has established a prima facie case of obviousness. is presented.

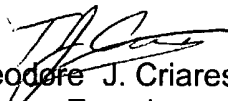
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Theodore J. Criares whose telephone number is (571) 272-0625. The examiner can normally be reached on 6:30 A.M. to 5:00P.M. Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax

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phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Theodore J. Criares  
Primary Examiner  
Art Unit 1617

TJC  
9/29/04